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|-------------------------------|------------------------|---------------------|--|
| <b>Notice of Allowability</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                               | 09/866,570             | CROTEAU ET AL.      |  |
|                               | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                               | Kathleen M Kerr        | 1652                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 9/11/2003.
2. ☒ The allowed claim(s) is/are 3-6, 8, 10, 11 and 14.
3. ☒ The drawings filed on 9/11/2003 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \* Certified copies not received: \_\_\_\_\_.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No. \_\_\_\_\_.
  - (b) ☐ including changes required by the proposed drawing correction filed \_\_\_\_\_, which has been approved by the Examiner.
  - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |  |  |
|--|--|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892)  | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 4 <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____    |
| 5 <input type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. _____               | 6 <input type="checkbox"/> Examiner's Amendment/Comment                    |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input type="checkbox"/> Examiner's Statement of Reasons for Allowance   |
|  | 9 <input type="checkbox"/> Other _____                                     |

## **DETAILED ACTION**

### ***Application Status***

1. In response to the previous Office action, a Final rejection (Paper No. 16, mailed on July 10, 2003), Applicants filed an after-final amendment and response received on September 11, 2003. Said amendment amended the specification, cancelled Claims 24-27, and amended Claims 8 and 14. Thus, Claims 3-6, 8, 10-11, and 14 are pending in the instant Office action and will be examined herein.

### ***Priority***

2. As previously noted, the instant application is granted the benefit of priority for the U.S. non-Provisional Application No. 09/457,046 (DIV) filed on December 7, 1999 and 09/411,145 (CIP) filed on September 30, 1999. Moreover, the elected Group drawn to TAX6 does not have priority back to the earliest date of September 30, 1999 since 09/411,145 teaches only TAX1 and TAX2.

### ***Drawings***

3. A complete set of formal drawings was received in response to the previous Office action. Said drawings have been approved by the Draftsmen and are, therefore, entered as formal drawings acceptable for publication upon the identification of allowable subject matter.

### ***Withdrawn – Objections to the Specification***

4. Previous objection to the Abstract for not completely describing the disclosed subject matter is withdrawn by virtue of Applicants' amendment.

5. Previous objection to the specification for being confusing in its varied use of the enzyme name for the claimed nucleic acid molecule encoding the TAX6 enzyme is withdrawn by virtue of Applicants' amendment to refer to TAX6 as O-acetyl transferase throughout the specification.

***Withdrawn - Claim Objections***

6. Previous objection to Claim 24 for having improper punctuation is withdrawn by virtue of Applicants' cancellation of said claim.

***Withdrawn - Claim Rejections - 35 U.S.C. § 112***

7. Previous rejection of Claims 8, 10, 11, 14, 24, and 26-27 under 35 U.S.C. § 112, second paragraph, as being indefinite for the activity of a transacylase is withdrawn by virtue of Applicant's amendment. Claims 24 and 26-27 have been cancelled. Claims 8 and 14 have been amended to include clear functional language for the claimed nucleic acid molecule.

8. Previous rejection of Claims 24 and 26-27 under 35 U.S.C. § 112, second paragraph, is withdrawn by virtue of Applicants' cancellation of said claims.

9. Previous rejection of Claims 8, 10, 11, 14, 24, and 26-27 under 35 U.S.C. § 112, first paragraph, written description, is withdrawn by virtue of Applicants' amendment. Claims 8, 10, 11, and 14 require a specific structure and a specific function to be within the scope of the claimed nucleic acid molecules.

***Withdrawn - Claim Rejections - 35 U.S.C. § 103***

10. Previous rejection of Claims 24 and 26-27 under 35 U.S.C. § 103(a) as being unpatentable over Menhard *et al.* or Zocher *et al.*, either in view of GenBank Accession Number AF456342, Matsudaira, Wozney, and Sambrook *et al.* is withdrawn by virtue of Applicant's cancellation of said claims.

***Status of Previously Pending Issues***

11. All previously pending objections/rejections have been withdrawn by virtue of Applicant's amendment. The drawings filed September 11, 2003 are formal.

***Conclusion***


12. Claims 3-6, 8, 10, 11, and 14 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Kerr whose telephone number is (703) 305-1229. The examiner can normally be reached on Monday through Friday, from 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathupura Achutamurthy can be reached on (703) 308-3804. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

KMK  
October 7, 2003

  
PONNATHAPU ACHUTAMURTHY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600